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EXAMINER

POON, KING Y

ART UNIT PAPER NUMBER

2624

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/631,987

Applicant(s)

HULAN, GREGORY T.

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-25 and 29-31 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/31/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 18, 26-28, are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/23/2005.
2. The amendment filed 7/31/2003 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: If for example, the photo package includes different sized photos the controller causes the scan module to print copies of a different photo size on an additional sheet when the photo package entry is entered.

As careful consideration of the application, the scan module disclosed is intended for scanning only and a print module is intended for printing only. Claim 8 of the originally filed claims appears to be a misprint.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

3. Claim 8 is objected to because of the following informalities: the limitations of "the controller causes the san module to print copies of a different photo size on an additional sheet when a photo package is selected" appear to be a misprint. The examiner has carefully review the entire specification and does not find any indication

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that the applicant intends to have the scan module used for printing. Appropriate correction is required. The examiner has not located any references that has a scan module, a print module and have the scan module to print on additional sheet when a photo package is selected and otherwise to have the print module to print.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how a scan module that does not have anything for printing would be able to print.

6. Claims 14, 22, 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "prompts for different standard photo sizes correspond to maximum printable area on a sheet" is subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 4, 5, 12-17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima (US 6,226,105).

Regarding claim 1: Fukushima teaches an apparatus (fig. 2) for scanning an image and printing copies of the image on a sheet (column 2, lines 43-50, column 4, lines 4-14), the apparatus comprising: a scan module (column 2, lines 43-45); a print module (column 4, lines 6-7); an input device for allowing a standard photo size to be selected (column 7, lines 14-25); and means (20, fig. 1) for causing the scan module to scan the image, the means determining an actual size of the scanned image and scaling copies of the scanned image to the selected photo size (column 8, lines 19-21), the means also causing the print module to print the copies on the sheet (print control of 20, fig. 1).

Fuskuski, does not uses automatically determine the scanned image size, in his invention.

However, Fuskuski, column 50-60, teaches such feature is well-known in the art and conventionally used, and certainly would be used in his system.

Fuskuski further states that such a techniques would increase the cost of the system (column 2, lines 1-3), and the main goal of Fuskuski is to reduced the cost of the conventionally system.

In other word, Fuskuski disclosed a convention aspect to his invention of automatically detecting the scanned image size, but for those that prefer saving money would choose to use his invention instead of using the automatic system.

Since it is a fact that a lot of people prefer "automatic" and paying a higher price for it, it would have been obvious to all persons; that: prefer washing machine to hand washing laundry (automatically washing clothes), prefer elevator to walking up the steps (automatically moving up), prefer automatic transmission to manual shift and especially for those that enjoy spending time doing other things in a shopping mall and let the system to automatically detects accurately the size of the scanned image in stead of trying to figure out or measuring what size is his photograph; at the time the invention was make to used automatically detecting the size of the scanned image feature in the system of Fuskuski.

Regarding claim 4: Fukushi teaches wherein the input device prompts for different standard photo sizes (column 7, lines 20-30).

Regarding claim 5: Fukushi teaches wherein the standard photo size is programmably stored in the means (column 7, lines 20-30).

Regarding claims 12, 13: Fukushi teaches the scanned image has one resolution and mixes color dots (column 6, lines 55-65)

Fukushi does not states that using the print module to print the copies of the scanned image on the sheet uses a single resolution for printing photos and mixes color dots to create colors.

Such technique is well-known in the art (official notice).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have provide system with using the print module to print the copies of the scanned image on the sheet uses a single resolution for printing photos and mixes color dots to create colors such that a high quality prints would be created with consistency and low cost without being hit with the time and cost of doing research (inherently properties of using well known method).

Regarding claim 14: Fukushi teaches prompts for different standard sizes corresponds to a maximum printable area on a sheet (column 9, lines 5-10).

Regarding claims 15, 16: Fukushi teaches standard printed size of a photograph are in metric/English unit of measure (column 6, lines 50-55; metric is a kind of English unit of measure because text book published in English to be used by the students includes metric system as units of measure).

Regarding claim 17: Fukushi teaches wherein the original is a photograph (column 11, lines 50-60).

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Regarding claim 19: Fukushi teaches wherein the apparatus is a digital copy machine (column 12, line 2).

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushi as applied to claim 1 above, and further in view of Hicks (US 4,862,200).

Regarding claim 2: Fukushi does not teach wherein the input device allows a Photo Package entry to be selected, and wherein the means causes copies of a different photo size to be printed on an additional sheet when the Photo Package entry is selected.

Hick, in the same area of printing photographs, teaches an input device (a code button, column six, lines 45) allows a Photo Package entry (package one, column six, line 45), which contains printing instructions such as printing copies of photograph of different sizes, to be selected, (column six, lines 20-25, column six, lines 44-50) and stored in a memory. (Column 6, lines 57-60) The instructions are transferred (column 10, lines 15-20, column 11, lines 25-28, lines 35-43) to a printer for printing the selected copies of photographs of different sizes.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fukushi's input device and controller to include: the input device allows a Photo Package entry to be selected, and the controller, that controls the print module, causes the print module to print copies of a different photo size when the Photo Package entry is selected.



It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fukushima's input device and controller by the teaching of Hicks because of the following reasons: Being a competitive business, there is very little margin for additional overhead costs, and the time is of the essence. The necessity of offering to a customer a choice creates significant problems of matching a particular subject with the subject's actual photographic order (Hicks, column 40-56). Therefore, the Photo package selection would automate the printing processing by allowing copies of different photographs to be automatically generated by a single entry and thereby, reduces the problem of matching a particular subject with the subject's actual photographic order as well as overhead costs.

Note: inherently, when the copies of the scanned image are printed for customer A on a sheet and the customer A take the photo; and at a later time, customer B's order using the photo package would have to be printed on an additional sheet.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima as applied to claim 1 above, and further in view of Collard (US 6,236,473).

Fukushima does not teach wherein the means rotates at least one copy to utilize maximum printable area on the sheet.

Collard, in the same area of printing images onto a sheet, teaches a control unit (column 7, lines 15-17) rotates (column 1, line 30, column 7, lines 31-32) an image such that the printed image fits the orientation of print area of a print sheet/utilized maximum printable area. (Column 1, lines 18-37, fig. 6B)

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Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fukushi system to include: rotates the image of a copy of the photograph such that the image fits the orientation of the print area designated (utilized maximum printable area)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fukushi's system by the teaching of Collard because of the following reasons: (a) it would have allowed printing possible, column 1, lines 50-55, Collard.

11. Claim 6, 7, 9, 20-25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushi (US 6,226,105) in view of Jamzadeh (US 5,889,578).

Regarding claim 6: Fukushi teaches all of the claimed limitations of claim 6 (please see discussion of claim 1) except the selected photo size are positioned to utilize maximum printable area on the sheet.

Jamzadeh, in the same are of printing photograph, teaches selected photo size are positioned to utilize maximum printable area on the sheet (nine 4R prints will fill up a sheet with no waste, column 7, lines 49-51. Five 4R one 8R and three 4R are selected to fill a sheet with no waste, column 7, lines 55-65).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fukushi system to include: the selected photo size are positioned to utilize maximum printable area on the sheet.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fukushi's system by the teaching of Jamzadeh because of the following reasons it would have reduced cost by saving paper from fitting an extra photograph onto a printable area of the paper.

Regarding claim 7: Fukushi teaches wherein the apparatus is an All-in-One machine (fig. 2).

Regarding claim 9: Fukushi teaches wherein the input device prompts for additional standard sizes (column 7, lines 20-30).

Regarding claims 20, 21: Fukushi teaches the scanned image has one resolution and mixes color dots (column 6, lines 55-65)

Fukushi does not states that using the print module to print the copies of the scanned image on the sheet uses a single resolution for printing photos and mixes color dots to create colors.

Such technique is well-known in the art (official notice).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have provide system with using the print module to print the copies of the scanned image on the sheet uses a single resolution for printing photos and mixes color dots to create colors such that a high quality prints would be created with consistency and low cost without being hit with the time and cost of doing research (inherently properties of using well known method).

Regarding claim 22: Fukushi teaches wherein the input device includes a set of entries for different standard photo sizes corresponds to a maximum printable area on a sheet (column 9, lines 5-10).

Regarding claims 23, 24: Fukushi teaches standard printed size of a photograph is in metric/English unit of measure (column 6, lines 50-55; metric is a kind of English unit of measure because text book published in English to be used by the students includes metric system as units of measure).

Regarding claim 25: Fukushi teaches wherein the original is a photograph (column 11, lines 50-60).

Regarding claim 29: Fukushi teaches wherein the apparatus is a digital copy machine (column 12, line 2).

12. Claims 10, 30, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushi in view of Rees (US 5,748,344) and Collard (US 6,236,473).

Regarding claim 10: Fukushi teaches an article of manufacture for an apparatus (fig. 2) including a scan module (10, fig. 1), a print module (30 or 80, fig., 1), an input device (column 5, lines 59-60), a display device (60, 220, fig. 1), and a processor (main processor, fig. 1), the article comprising: computer memory (inherent as well as well known in the art for processor's operation); and a program stored in the computer memory, the program, when executed, commanding the processor to display a Photo Features entry on the display device (column 7, lines 20-30); the program further commanding the processor to determine actual size of an output of the scan module

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(scaling, column 8, lines 19-30; column 9, lines 58-59); command the scan module to perform a full scan (column 9, lines 45-50); generate scaled copies of an output of the scan module after the full scan is performed (column 8, lines 19-35), the copies being scaled to a size indicated by the selected entry.

Fuskuski, does not use automatically determine the scanned image size, in his invention.

However, Fuskuski, column 50-60, teaches such feature is well-known in the art and conventionally used, and certainly would be used in his system.

Fuskuski further states that such a techniques would increase the cost of the system (column 2, lines 1-3), and the main goal of Fuskuski is to reduced the cost of the conventionally system.

In other word, Fuskuski disclosed a convention aspect to his invention of automatically detecting the scanned image size, but for those that prefer saving money would choose to use his invention instead of using the automatic system.

Since it is a fact that a lot of people prefer "automatic" and paying a higher price for it, it would have been obvious to all persons; that: prefer washing machine to hand washing laundry (automatically washing clothes), prefer elevator to walking up the steps (automatically moving up), prefer automatic transmission to manual shift and especially for those that enjoy spending time doing other things in a shopping mall and let the system to automatically detects accurately the size of the scanned image in stead of trying to figure out or measuring what size is his photograph; at the time the invention

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was made to used automatically detecting the size of the scanned image feature in the system of Fuskuski.

Since Fuskuski does not use automatically determine the scanned image size, in his invention, a person with ordinary skill in the art must relies and go out and search for automatically detecting the size of the scanned image.

Rees teaches it is well known in the art to used a prescan process to detect the size of a media to be scanned and use a full scan to read in the image for scaling (column 5, lines 55-65).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fuskuski to include: used a prescan process to detect the size of a media to be scanned and use the full scan to read in the image for scaling when the print size is selected.

Fukushi does not teach wherein the processor rotates at least one copy to utilize a greater printable area on the sheet.

Collard, in the same area of printing images onto a sheet, teaches a control unit (column 7, lines 15-17) rotates (column 1, line 30, column 7, lines 31-32) an image such that the printed image fits the orientation of print area of a print sheet/utilized greater printable area. (Column 1, lines 18-37, fig. 6B)

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fukushi system to include: rotates the image of a copy of the photograph such that the image fits the orientation of the print area designated (greater printable area).

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It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fukushima's system by the teaching of Collard because of the following reasons: (a) it would have allowed printing possible, column 1, lines 50-55, Collard.

Regarding claims 30: Fukushima teaches the scanned image has one resolution and mixes color dots (column 6, lines 55-65)

Fukushima does not state that using the print module to print the copies of the scanned image on the sheet uses a single resolution for printing photos and mixes color dots to create colors.

Such technique is well-known in the art (official notice).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have provided system with using the print module to print the copies of the scanned image on the sheet uses a single resolution for printing photos and mixes color dots to create colors such that a high quality prints would be created with consistency and low cost without being hit with the time and cost of doing research (inherently properties of using well known method).

Regarding claim 31: Fukushima teaches prompts for different standard sizes corresponds to a maximum printable area on a sheet (column 9, lines 5-10).

13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima in view of Rees (US 5,748,344) and Collard (US 6,236,473) as applied to claim 1 above, and further in view of Hicks (US 4,862,200).

Regarding claim 11: Fukushi does not teach wherein the input device allows a Photo Package entry to be selected, and wherein the means causes copies of a different photo size to be printed on an additional sheet when the Photo Package entry is selected.

Hick, in the same area of printing photographs, teaches an input device (a code button, column six, lines 45) allows a Photo Package entry (package one, column six, line 45), which contains printing instructions such as printing copies of photograph of different sizes, to be selected, (column six, lines 20-25, column six, lines 44-50) and stored in a memory. (Column 6, lines 57-60) The instructions are transferred (column 10, lines 15-20, column 11, lines 25-28, lines 35-43) to a printer for printing the selected copies of photographs of different sizes.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fukushi's input device and controller to include: the input device allows a Photo Package entry to be selected, and the controller, that controls the print module, causes the print module to print copies of a different photo size when the Photo Package entry is selected.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Fukushi's input device and controller by the teaching of Hicks because of the following reasons: Being a competitive business, there is very little margin for additional overhead costs, and the time is of the essence. The necessity of offering to a customer a choice creates significant problems of matching a particular subject with the subject's actual photographic order (Hicks,



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column 40-56). Therefore, the Photo package selection would automate the printing processing by allowing copies of different photographs to be automatically generated by a single entry and thereby, reduces the problem of matching a particular subject with the subject's actual photographic order as well as overhead costs.

Note: inherently, when the copies of the scanned image are printed for customer A on a sheet and the customer A take the photo; and at a later time, customer B's order using the photo package would have to be printed on an additional sheet.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 2, 2006



**KING Y. POON**  
**PRIMARY EXAMINER**